

REMARKS

The Applicants respectfully request the Examiner to reconsider the Present Patent Application in light of the amendments and arguments presented. The Applicants submit that neither the New Claims or nor the amendments presented in this First Amendment contain new matter.

Section D- Objections under Section 112

In Section 1 of the Office Action, the Examiner objected to Claims 3-7 under Section 112 because Dependent Claims 3 through 7 originally recited the text “satellites operate” while Claim 2, upon which Claims 3-7 depend, recites “a satellite”. The Applicants have cured this typographical error by amending Claims 3-7 so that they now recite the text “satellite operates”.

In Claim 5, the Applicants have also corrected a typographical error by replacing “hgih” with “high”.

Section 1 of the Office Action also contained an objection to Claims 18 and 19, which were identical in the Original Application. The Applicants have corrected the typographical error in Claim 19 by replacing “on the Earth’s surface” with “**above** the Earth’s surface”. The Applicants submit that the presentation of identical Claims 18 and 19 in the Original Application was an unintentional error. Support for both Claim 18 and 19, as amended, may be found on page 6 of the Original Application, which states that:

“The satellite is capable of delivering packets of data to many different types of terminals, including residences R, office buildings OB, cars and other vehicles C, aircraft A and boats B.”

Present Application, Page 6, as amended.

In Section 1 of the Office Action, the Patent Office further objected to Claims 11-24 under Section 112 because Original Claim 11 recited “said satellite means” which lacks an antecedent basis. The Applicants have amended Claim 11 by replacing “satellite means” with “**relay** means”, and submit that the recitation of “satellite means” in Original Claim 11 was an unintentional error.

The Applicants respectfully submit that these amendments to Claims 3-7 and 18-19 overcome the objections presented in Section 1 of the First Office Action.

The Applicants have also corrected spelling errors that occurred on pages 6 and 7 of the Original Application.

Section E- Rejections under Section 102(e) & 103(a)

In Section 3 of the First Office Action, Claims 1-2, 8-20, and 23-24 were rejected under Section 102(e) as being anticipated by U.S. Patent No. 6 029 045 (Picco '045). In Section 4 of the First Office Action, Claims 3-7 and 21-22 were rejected under Section 103(a) as being obvious over Picco '045. The Applicants respectfully submit that the Claims, as amended, are neither anticipated or nor suggested by Picco.

The Applicants have amended Independent Method Claim 1 and Independent Apparatus Claim 11 to more particularly point out the subject matter which the Applicants regard as their Invention. Both Amended Claims 1 and 11 now contain specific recitations which describe one of the Invention's novel and non-obvious features. Amended Claims 1 and 11 distinguish the Applicants' Invention from Picco by reciting the on-demand use of content at a time that is always selected by the recipient of the content. The recipient always has control over the selection of content, and the time the content is reproduced.

In sharp contrast, Picco is concerned only with the replacement of national advertising on cable television systems with local or regional advertising. Picco states that:

“The invention provides a broadcaster with a system to provide targeted content to its users **wherein the content is under the control of the broadcaster and the viewer is unaware of the targeted content.** This permits a broadcaster to deliver geographically localized content (e.g., commercials targeted for a particular area of the country) over a national transmission medium, such as a satellite. The system may also permit a user to specify preferences for the local content that the user will receive and then deliver local content that best satisfies those preferences.”

“The invention permits a broadcaster to segment its viewers for advertisers so advertisers may target their commercials at a particular portion of the broadcaster's audience. Thus, the broadcaster can segment their viewers and the advertiser's benefit since they are able to more effectively reach viewers who are more likely to be interested in their product often at a lower total cost since the advertiser does not have to purchase the rights to advertise in the entire market.”

Picco, Column 2, Line 49, emphasis added; and Column 3, Lines 1-62.

According to Picco, although a subscriber to the cable system can indicate a preference for the general type of local content that will be received, and the broadcaster will attempt to deliver local content that “best satisfies” the viewers’ preferences, the local content is, by the express terms of the Picco disclosure, “under the control of the broadcaster”.

In addition to controlling the content of broadcasts exclusively by the broadcaster, Picco also discloses that the broadcaster controls the time that the broadcasts (i.e., the substitute advertisements) are broadcast to the subscribers of the system. This is completely different from the Applicants’ Invention, which always provides “on-demand” content. The viewer, listener or recipient of the content always has the power to select content, as well as the freedom to choose the time of use.

The Patent Office has rejected Claims 1 and 11 as being anticipated by Picco. It is well established that a rejection of a claim as being anticipated by a prior art reference requires the Patent & Trademark Office to establish a strict identity of invention between the applied reference and each rejected claim. Stated in other words, a rejection based on anticipation is inappropriate unless a single applied reference discloses all features of the rejected claim, as arranged in the claim. See, for example, *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983). In the instant case, it clear that there is no strict identity between the Picco Patent and either Independent Claims 1 or 11, and thus the applied reference does not anticipate (or suggest) the Applicants’ Amended Claims.

Claims 1 and 11 have been amended to more clearly distinguish them over the disclosure of Picco. In accordance with the methods and apparatus defined by these Claims, a recipient of content is empowered by the invention to chose content, and to chose the time to listen, view or otherwise perceive content. Unlike Picco, which gives all control over the selection and time of use of content to the broadcaster, the Applicants' Invention provides the recipient of the content with the exclusive control over content that has been delivered to and stored in his or her receiver.

The Applicants submit that Independent Claims 1 and 11 are allowable over the prior art applied in the First Office Action. The remaining Dependent Claims, which depend directly or indirectly from one of Claims 1 or 11, are each allowable, at least for the same reasons as their respective Parent Claims.

Section F- Provisional Double Patenting Rejections

In Section 5 of the First Office Action, the Patent Office rejected Claims 1-10 under Section 101 “as claiming the same invention as that of claims 1-6 and 8-10 of copending Application No. 09/833,094.”

In Section 6 of the First Office Action, the Patent Office rejected Claim 11 under the judicially created doctrine of obviousness-type double patenting “as being unpatentable over claim 20 of copending Application No. 09/833,094.”

The Applicants respectfully submit that, as of the date of submission of this First Amendment, U.S. Patent Application Serial No. 09/833,094 has not been granted, nor has any Office Action been received from the Patent Office. The Applicants therefore respectfully request the Patent Office to withdraw the rejections based on double patenting that were presented in Sections 5 and 6 of the First Office Action.

Section G- Summary of Status of All Claims in the Present Application

Claim 1	Amended in this First Amendment.
Claims 2	Unchanged.
Claims 3-7	Amended in this First Amendment.
Claims 8-9	Unchanged.
Claims 11	Amended in this First Amendment.
Claim 12-18	Unchanged.
Claim 19	Amended in this First Amendment.
Claims 20-24	Unchanged.
Claims 25-26	New, added in this First Amendment.

CONCLUSION

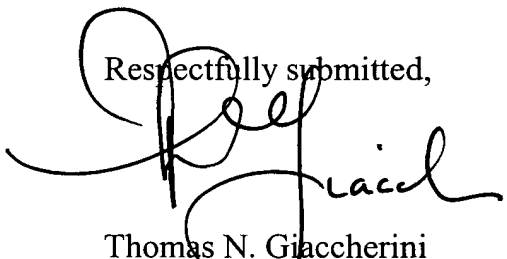
Section H- Fees & Request for Allowance

The Applicants respectfully submit that neither the New Claims nor the amendments presented in this First Amendment contain new matter, and are fully supported by the Specification and Drawings as originally filed.

The Applicants believe that a fee for two new Dependent Claims (25 & 26) is required to enter this First Amendment. A Credit Card Authorization Charge Form accompanies this First Amendment to authorize the payment of the \$18 small entity fee for the two New Dependent Claims, and the \$475 fee for the Petition for Three Month Extension of Time. The total authorized charge is \$493.

The Applicants respectfully request that the all of the Pending Claims be allowed, and this Application be passed to issue.

Respectfully submitted,

 2 April
2004.

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Transmitted to the U.S. Patent Office
with a Rule 8 Certificate by facsimile
on 2 April 2004.